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41319-904846

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of : Elberse, Arik
Serial No. : 09/707,015
Filed : November 06, 2000
For : Method of Using a Web-Browser to Pass
Information from a First Web-Entity to One of
a Plurality of Second Web-Entities
Examiner : Lezak, Arrienne M
Art Unit : 2143
Customer number : 23644

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Name of person signing Minnie Wilson

Signature Minnie Wilson

APPEAL BRIEF

Honorable Director of Patents and Trademarks

PO Box 1450

Alexandria, VA 22313-1450

Dear Sir:

This appeal is from the Examiner's final Office Action mailed May 8th, 2005
and the Advisory Action mailed August 25th, 2005 in which all pending claims
(namely Claims 1 to 3 and 5 to 20) were rejected. A timely Notice of Appeal was
filed with the required fee.

This brief is being filed along with the required \$500 fee pursuant to 37 C. F. R. §
41.20(b)(2).

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(i) Real Party in Interest

This application is assigned to Nortel Networks Limited, who is the real in interest.

(ii) Related Appeals and Interferences

There are no related appeals or interferences.

(iii) Status of Claims

This application was filed with claims 1 to 20. In the response of April 22, 2004, July 28, 2004 and March 22, 2005, claim 4 was cancelled and claims 1, 2, 10, 12, 15 and 18 amended. During amendment, independent claims 1, 10, 12, 15 and 18 have each been amended to recite features patentably distinguishing the invention over the prior art of record. Claims 1-3 and 5-20 are those claims appealed, and they are set forth in the Claims Appendix.

(iv) Status of Amendments

No further amendments to the claims were made in the after-final response of August 8, 2005, which response was entered by the Examiner, so the claims now pending have all been considered by the Examiner and finally rejected. It is the rejection of these claims as set forth in the Advisory Action mailed August 25, 2005 that is appealed.

(v) Summary of Claimed Subject Matter

The invention as presently claimed is concerned with how to pass information from one of a plurality of first web entities to a second web entity where the one of the plurality of first web entities has no information, e.g. an address, identity or location, of the second web entity. This problem is addressed by means of a client web browser that does have the necessary information (i.e. the address etc.) about the second web entity. The method comprises the one of the plurality of first web entities sending a pre-specified address of a redirection server together with other information intended for the second web entity to the client web browser. The client web browser sends the address of the second web entity to the redirection server whereby the redirection server redirects the client web browser to the second web entity. Then, the client web browser connects to the second web entity and passes to it the other information previously provided to the client web browser by the one of the plurality of first web entities.

It can be seen therefore that the one of the plurality of first web entities has no, and never needs to have any, address, identity or location information relating to the second web entity in order for it to pass information to the second web entity. This is advantageous in that the first web entities are not burdened with keeping tables or databases comprising address information for all possible second web entities.

Reference is made to demonstrative Exhibit 1 appended hereto which provides a visual representation of how information from one of a plurality of first web entities is passed to a second web entity where the one of the plurality of first web entities has no information about the identity etc. of the second web entity in accordance with the claimed invention. In the Exhibit, four steps labelled 1 to 4 are identified as comprising the process of passing information from one of a plurality of first web entities a second web entity where the one of the plurality of first web entities has no information about the identity of the second web entity. The four steps in association

with the visual representation of the claimed invention clearly demonstrate that the one of a plurality of first web entities need have no knowledge of the identity/address/location etc. of the second web entity to which it wishes to pass information.

The system of the present application makes a useful contribution to the art in that it enables information (such as a telephone number or TV program data) to be conveyed from a web based information system (first web entity) to an information receiver (second web entity - such as a suitably enabled telephone set or a video recorder) without the web based information system knowing or needing to know the identity/address/location of the information receiver. Consequently, the web based information system is not burdened with maintaining a vast database of identity/address/location data on all information receiving devices or systems nor are the operators of such information receivers burdened with having to provide data about their information receivers to (i.e. register with) the web based information system.

(vi) Grounds of Rejection To Be Reviewed on Appeal

There are two rejections at issue:

1. the rejection of claims 10 and 12 to 20 under 35 U.S.C. §102(b) as being anticipated by US Patent Number 6466966 to Kirsch; and
2. the rejection of claims 1 to 3, 5 to 9, 11, 16, 19 and 20 under 35 U.S.C. §103(a) as being unpatentable over US Patent Number 6466966 to Kirsch in view of US Patent Number 6070191 to Narendran.

(vii) Argument

Ground 1:

Reference is made to demonstrative Exhibits 1 and 2 appended hereto. Exhibit 1 as has already been mentioned provides a visual representation of how information from one of a plurality of first web entities is passed to a second web entity where the one of the plurality of first web entities has no information about the identity of the second web entity in accordance with the claimed invention. By way of comparison, Exhibit 2 provides a visual representation of the process taught by Kirsch. Thus, Exhibits 1 and 2 illustrate schematically the respective different processes of the present application and Kirsch.

In Kirsch (claim 1, for example), it can be seen that there is defined a relationship between a first server system, a second server system logically external to the first server system and a client web browser on a client computing device. The first server system is arranged to provide a web page to the client with an embedded URL reference to a web page served by the second server system (column 7, lines 10 to 13). In order that the first server system can track the number of instances that client web browsers access embedded URLs for second server system web pages in web pages served by the first server system, selection of the embedded URL by the client web browser results in an HTTP transaction with the first server system rather than with the targeted second server system (column 7, lines 14 to 17). Thus, the information stored in the embedded URL first served to the client web browser by the first server system is returned to the first server system even though the second server system is the target of the embedded URL. The first server system then provides a redirection response (message) to the client web browser including a reference to the second server system to enable the web browser to connect to the second server system. Thus, it is clear that the first server system must have prior knowledge such as one of an identity, location or address of the second server

system and must therefore store knowledge of all such second server systems for which it provides embedded URLs in web pages served to client browsers.

More specifically, Kirsch is concerned with measuring the effectiveness of an advertisement on a web page. Kirsch explains at column 2 lines 43 to 49 that, *“A more direct measure of the effectiveness of a particular advertisement on a particular web page is the number of times a client web browser chooses to actively pursue the URL represented by the advertisement. Thus there is a need to be able to track information obtainable from a client browser when a hyper-linked advertiser’s URL is selected.”*

Consider that the advertisement is provided on a host web page provided by a server A (first server system). Consider also that the advertisement contains a URL to information hosted on a destination server B (second server system). The method of Kirsch provides that the advertisement contains a URL pointing back to server A instead of server B. Thus server A is aware of all requests to access the information on server B via the advertisement. That is, server A is able to assess the effectiveness of the advertisement. Also server A is able to seamlessly re-direct the client (client system/web browser) to server B using the information in the received URL. This is explained in Kirsch at column 6 line 52 to column 7 line 40 and claim 1 of Kirsch.

In Kirsch server A needs to have knowledge about destination server, server B. In contrast, a primary object of the present invention is to avoid the need for this knowledge. In the present invention the source server, server A is for example a web-based information system providing telephone numbers. The destination entity, “server B”, is for example a user’s telephone 304 for initiating a telephone call to a telephone number selected by the user from the web-based information system. In the present invention server A has no knowledge about “server B”. The present invention thus enables new services to be provided such as phone number white

pages with active URLs that activate the client's standard telephone and cause it to automatically out-dial to that number.

Thus, in contrast to Kirsch, the web based information system (comprising the one of a plurality of first web entities in Exhibit 1 and akin to the first server system of Kirsch in Exhibit 2) as defined by claim 10 of the present application is arranged such that it has no (and never has any) information such as identity/location/address about the information receiver (the second web entity in Exhibit 1 and akin to the second server system in Exhibit 2). Consequently, Kirsch does not teach all of the claims limitations of claim 10 which is therefore not anticipated by Kirsch.

It is also noted that Kirsch does not disclose an "information receiver" as would be understood by a skilled addressee within the context of the present invention. Kirsch discloses a second server system arranged to serve web pages to client web browsers. For this reason also, claim 10 is not anticipated by Kirsch.

Independent claim 12 is the method counterpart of claim 10 so the foregoing analysis applies equally thereto. Claim 12 is therefore not anticipated by Kirsch.

Independent claim 15 is directed to a redirection server. In Kirsch, the first server system comprises the redirection server. It is implicit from claim 15 that the web server for redirecting (redirection server) is a separate entity to that of the web based information system (akin to the first server system of Kirsch). Thus, claim 15 is not anticipated by Kirsch.

Independent claim 18 is a computer program counterpart to claim 15 and so is also not anticipated by Kirsch.

Referring to independent claim 19, it will be noted that in Kirsch the first server system provides the client web browser with a redirection message including a

reference to the second server system such that the client web browser can send an HTTP request to the second web server to request a web page. Thus, Kirsch does not disclose a client web browser that is arranged to generate cookies for each of an information receiver and a redirection server. Also, as previously noted, Kirsch does not disclose an "information receiver". Consequently, claim 19 is not anticipated by Kirsch.

Since claims 13, 14, 16, 17 and 20 depend from independent claims that are novel over Kirsch, these claims are also not anticipated by Kirsch.

Ground 2:

In *ex parte* examination of patent applications, the Patent and Trademark Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent and Trademark Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent and Trademark Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985). A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d

781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As already discussed herein, Kirsch discloses a first server system that must have knowledge of a second server system to which it redirects a client web browser. In contrast, as defined by claim 1 of the present application, the first web entity is arranged such that it has no knowledge of the second web entity. Also, in Kirsch, the first server system comprises the redirection server whereas in the present invention as defined in claim 1, it is implicit that the redirection server is a separate entity to the first web entity. Further, in Kirsch, there is no concept of the client web browser being arranged to provide "additional information" to the second server system whereas in the present application the client web browser provides additional information to the second web entity, the additional information being provided by the first web entity. Consequently, Kirsch fails to teach many of the claims limitations of claim 1 and since these are not taught by Narendran, the Examiner has failed to satisfy the burden incumbent in law under 35 U.S.C. §103(a) to establish a *prima facie* case of obviousness.

The method of claim 1 of the present application makes a useful contribution to the art in that it enables additional information (such as a telephone number or TV program data) to be conveyed from a first web entity to a second web entity (such as a suitably enabled telephone set or a video recorder) without the first web entity knowing or needing to know the identity/address/location of the second web entity.

Consequently, the first web entity is not burdened with maintaining a vast database of data on all second web entities nor are the operators of such second web entities burdened with having to provide data about their second web entities (i.e. register) to the first web entity.

There is nothing in the disclosure of Narendran that would enable a skilled addressee to overcome the failings of Kirsch as regards the method of the present invention as defined by claim 1.

Also, a skilled addressee would not seriously contemplate modifying Kirsch as a means of arriving at the method of claim 1 since, in order to do so, he/she would have to go directly against the teaching of Kirsch which has a requirement that the first server system must have knowledge of the second server system. The whole point of the present invention is that the first web entity does not (and need not) have information pertaining to the second web entity. Thus, it is not disadvantaged in having to maintain a database of information for a plurality of second web entities. Nor are operators of such second web entities burdened with having to register (provide information about) their second web entities to said first web entity.

Consequently, the combination of Kirsch and Narendran not only does not teach all the claims limitation of claim 1 but this combination could not lead a skilled addressee to the method defined by claim 1.

Since claims 2, 3 and 5 to 9 are dependent from claim 1, these claims are also not rendered obvious by the combination of Kirsch and Narendran.

The rejection of claims 11, 16, 19 and 20 under 35 U.S.C. §103(a) is moot in view of the foregoing.

Reversal of the Examiner is therefore clearly in order and is solicited.

December 14, 2005

Respectfully submitted,

William M. Lee, Jr.
Registration No. 26,935
Barnes & Thornburg LLP
P.O. Box 2786
Chicago, Illinois 60690-2786
(312) 214-4800
(312) 759-5646 (fax)

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Claims Appendix

1. A method of using a web-browser to pass information from one of a plurality of first web entities to a second web entity said web-browser being separate from said first and second web-entities and said one of a plurality of first web entities having no information about the second web entity, said method comprising the steps of:-

- (i) receiving a pre-specified address of a redirection server, together with additional information, from the one of a plurality of first web entities at the web-browser;
- (ii) forwarding an address of the second web-entity to the redirection server from the web-browser such that the redirection server redirects the web-browser to the second web-entity and
- (iii) passing the additional information from the web-browser to the second web-entity.

2. A method as claimed in claim 1 wherein the one of a plurality of first web entities is a web-based information system.

3. A method as claimed in claim 1 wherein the second web-entity is an information receiver.

4. (cancelled).

5. A method as claimed in claim 1 wherein said step (ii) comprises forwarding the additional information to the redirection server together with the address of the second web-entity.

6. A method as claimed in claim 1 wherein the additional information comprises a telephone number and the second web-entity comprises a node in a telecommunications network.

7. A method as claimed in claim 1 wherein the additional information comprises television programme information and wherein the second web-entity comprises a video recorder.

8. A method as claimed in claim 1 wherein the address of the second web-entity is forwarded to the redirection server in a cookie from the web-browser.

9. A method as claimed in claim 1 wherein said additional information comprises instructions for an action to be performed at the second web entity.

10. A web-based information system arranged to provide items of information for receipt by an information receiver, said web-based information system comprising:-

- (i) an input arranged to receive instructions from a web-browser such that an item of information from a database may be accessed and selected; said web-browser being separate from said web-based information system and said information receiver;
- (ii) an output arranged to forward a pre-specified address of a redirection server together with an item of information accessed from the database to the web-browser; such that said web-based information system has no information about the information receiver.

11. A web-based information system as claimed in claim 10 wherein said database of items comprises telephone numbers.

12. A method of operating a web-based information system which is arranged to provide items of information for receipt by an information receiver said method comprising the steps of:-

- (i) receiving instructions from a web-browser such that an item of information from a database is accessed and selected; said web-browser being

separate from said web-based information system and said information receiver;

- (ii) forwarding a pre-specified address of a redirection server together with the accessed, selected item of information to the web-browser; such that said web-based information system has no information about the information receiver.

13. A communications network comprising a web-based information system as claimed in claim 10.

14. A communications network as claimed in claim 13 which further comprises at least one redirection server.

15. A web server for redirecting a web-browser said web server comprising:

- (i) an input arranged to receive from the web-browser an address of a web-entity together with additional information said additional information having been obtained from a web-based information system which has no information about the web-entity; said web-browser being separate from the web-server, the web-entity and the web-based information system; and
- (ii) a processor arranged to redirect the web-browser to the web-entity such that in use the web-browser may send the additional information to the web-entity.

16. A web server as claimed in claim 15 wherein said input is arranged to receive a cookie from the web-browser, said cookie containing the address of the web-entity.

17. A web server as claimed in claim 15 wherein the web entity is itself a web server for redirecting a web-browser.

18. A computer program for controlling a web server in order to redirect a web-browser, said computer program being arranged to control the computer program such that :-

- (i) an address of a web-entity is received from the web-browser together with additional information said additional information having been obtained from a web-based information system which has no information about the web-entity; said web-browser being separate from the web server, the web-entity and the web-based information system; and
- (ii) a processor redirects the web-browser to the web-entity such that in use, the web-browser may send the additional information to the web-entity.

19. A method of using a web-browser to generate cookies for each of an information receiver, and a redirection server, said method comprising the steps of:-

- (i) accessing the information receiver using the web-browser; and
- (ii) automatically redirecting the web-browser to the redirection server.

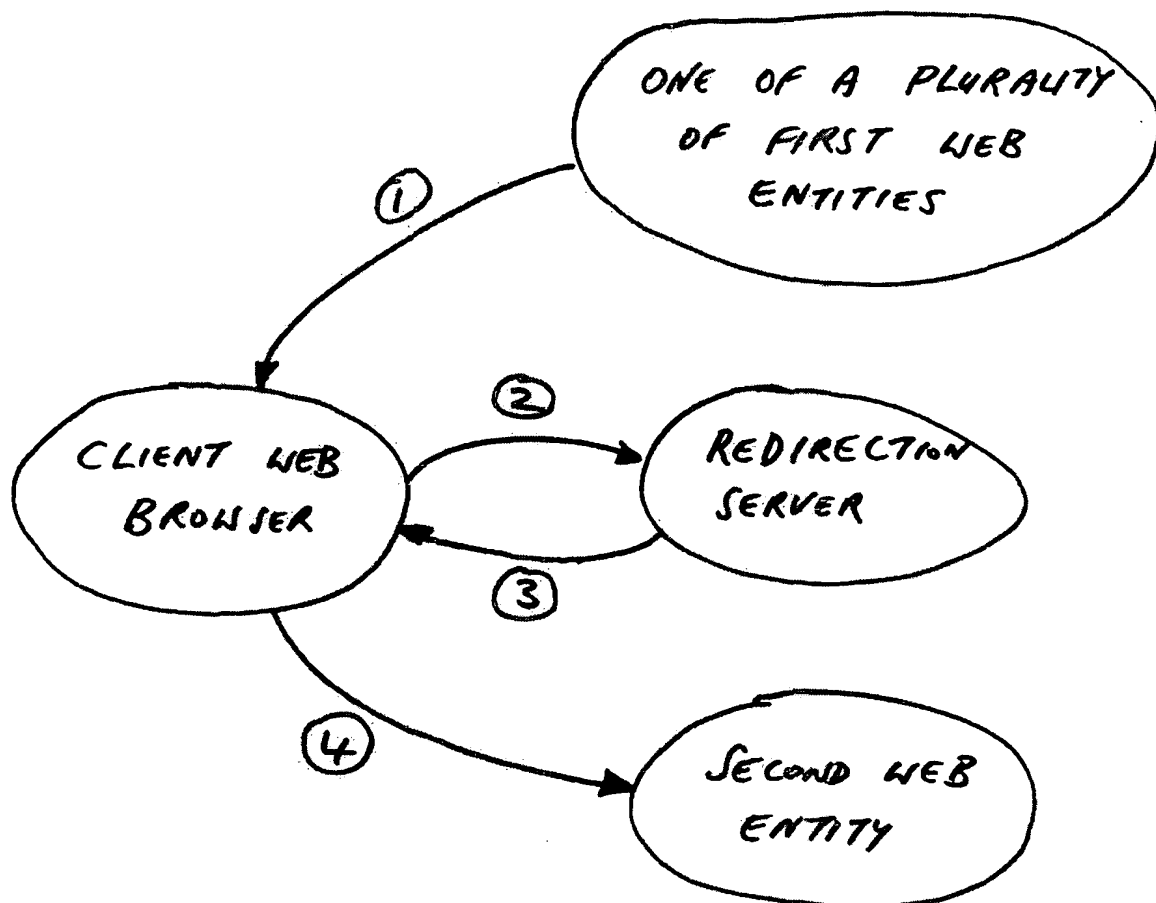
20. A method as claimed in claim 19 which further comprises repeating said step (ii) of automatically redirecting for one or more additional redirection servers.

Evidence Appendix and Related Proceedings Appendix

There is no evidence appendix or related proceedings appendix.

Exhibit 1

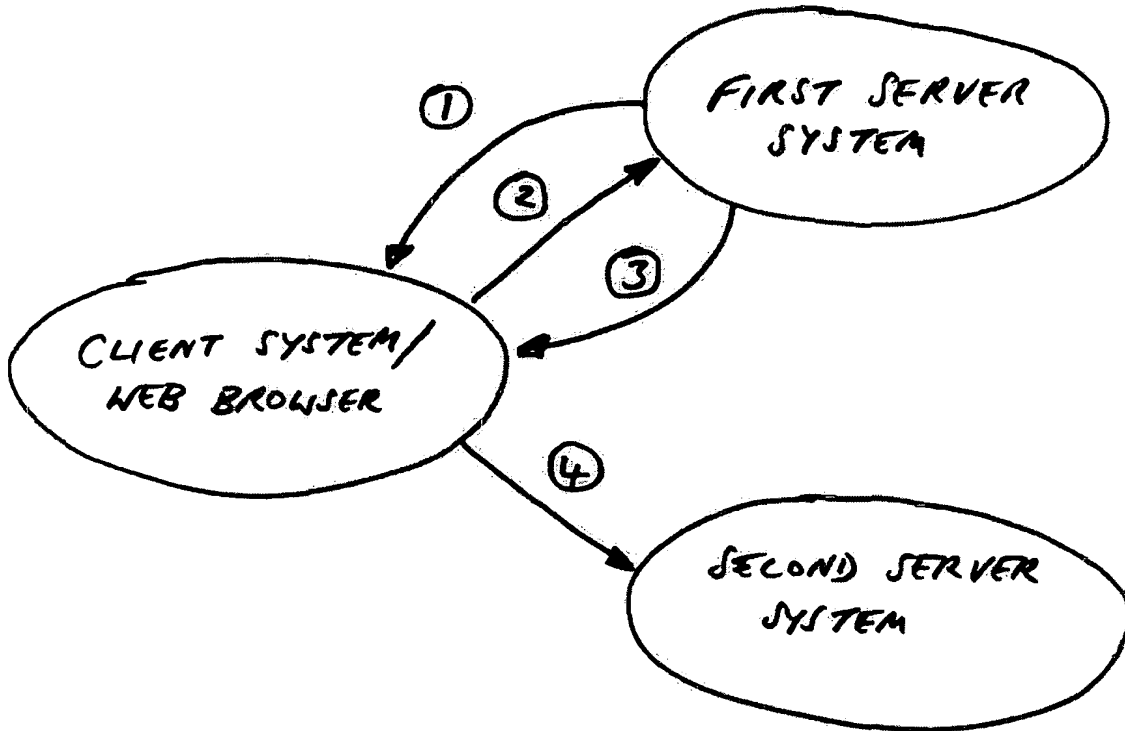
Present Application – US Serial Number 09/707,015



1. One of a plurality of first web entities provides to the client web browser a pre-specified address of the redirection server and additional information to be passed to the second web entity.
2. Client web browser passes address of the second web entity already known to it to the redirection server.
3. Redirection server provides client web browser with redirection information for connecting to the second web entity.
4. Client web browser uses redirection information to connect to second web entity in order to provide to the second web entity the additional information previously provided by the one of a plurality of first web entities.

Exhibit 2

Kirsch – US Patent Number 6466966



1. The first server system provides the client system (web browser) with a predetermined URL referencing the first server system, the predetermined URL being encoded with predetermined redirection and accounting data including a reference to the second server system.

2. Client web browser sends predetermined URL to the first server system, said first server system decoding the redirection and accounting data including the reference to the second server system encoded in said URL.

3. The first server system provides the client web browser with said redirection and accounting data and a redirection message including said reference to said second server system.

4. The client web browser uses the redirection message including said reference to said second server system to connect to said second server system.